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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,028	04/13/2004	Stephen Byng	18266US01	6043
23446 7590 10/26/2009 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661				
EXAMINER				
YOO, JASSON H				
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3714				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/824,028

**Applicant(s)**

BYNG, STEPHEN

**Examiner**

JASSON H. YOO

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 64-69, 71, 72, 74-77, 79, 80, 82 and 83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64-69, 71, 72, 74-77, 79, 80, 82 and 83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/19/09 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 64-69, 71-72, 74-77, 79-80, 82-83 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's specification fails to disclose that the acceptance to join the cooperative gaming environment is received before establishing the at least one rule, and before commencing the cooperative game. Applicant's specification discloses that the player can join the

cooperative gaming environment by registering their interest (paragraph 65). Applicant also discloses how the player joins or accepts to join the cooperative gaming environment in paragraphs 18, 20, 30, 42, 44, 52, 65-68, 95, 109, 118-119. The descriptions of accepting to join the cooperative gaming environment or joining the cooperative gaming environment is directed to joining or accepting the cooperative game within the cooperative gaming environment. The player registers to participate in the cooperative gaming environment, but the player does not join the cooperative gaming environment before establishing the rules and before commencing the cooperative game. A player first registers to the cooperative gaming environment. After a player registers, at least one rule is established. After the at least one rule is established, the player can then accept to join the cooperative gaming environment when commencing the cooperative game. Therefore a registered player may not accept to participate in the cooperative gaming environment (as explicitly disclosed in paragraph 42 of Applicant's specification).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 71-72 and 82-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 71 and 82 incorporates the claim limitation of, "wherein the establishing of at least one rule includes changing the at least one rule." It is not clear how establishing the at least one rule includes changing the at least one rule. Establishing a rule is to cause the rule to be accepted or to create a rule. Changing the at least one rule is to cause the rule to change and thus not be accepted. Changing a rule, replaces a rule, rather than creating a rule. Thus changing the rule will be un-establishing the rule. Therefore it is not clear how the step of establishing of at least one rule includes changing the at least one rule.

Claims 72 and 83 incorporate the claim limitation of "presenting (to present in claim 83) another rule during the cooperative game". It is not clear how the term "presenting" and the term "to present" are used. The claim limitation of "presenting" and "to present" in claims 64 and 74 is used to describe that a game rule is initially provided on the gaming system. Applicant's specification discloses that the rules are established before the cooperative game begins. Applicant's specification explicitly discloses that players must abide by the rules already present, paragraph 118. It appears that claims are directed to another rule being available during the cooperative game. Thus, the rules are established before the cooperative game and available to be applicable during the cooperative game. The claim limitation of "presenting" and "to present" in claims 72 and 83 will be interpreted as available or occurring.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 64-69, 71-72, 74-77, 79-80, 82-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 2003/0064807).

Claims 64, 74. Walker discloses a gaming system (104 in Fig. 3) comprising a controller (330 in Fig. 3) and method for use with the gaming system, the method comprising:

presenting an invitation on said gaming system allowing a person to join a cooperative game environment (Casino server transmit a message to user's gaming device to register for group play or to play in a group; paragraphs 123, 126-131);

receiving an acceptance to join said cooperative gaming environment through said invitation on said gaming system (The user communicates to the casino server his willingness to join the group, or selects a group; paragraphs 130-132. The user interacts with the gaming device using the user input device 312 in Fig. 3.);

establishing at least one rule for a cooperative game that can be played by the cooperative gaming environment after receipt of said acceptance (Walker discloses that rules are in the form of group format and objectives; paragraphs 57-58. Group members may establish the group format and objectives for the group; paragraphs 144-145. The

rule is established after the group is formed, and thus after the receipt of the acceptance; Steps S1 and S2 in Fig. 12).

presenting the at least one rule to the person on said gaming system allowing the person to accept said at least one rule prior to commencing the cooperative game (The rule is presented on the display device 308 in Fig. 3 of the gaming system when the user establishes the rules/objectives; paragraph 144-145. The rules/objectives are accepted by the user in order to initiate the cooperative game; s2 and s3 in Fig. 12. Furthermore, the group play begins after every group member agrees to begin, paragraph 229.).

Walker discloses the claimed invention as discussed above but fails to explicitly disclose that the person is presented with an option on the gaming system to withdraw from the cooperative gaming environment subsequent to presenting the at least one rule to the person and prior to commencing the cooperative game. Nevertheless, it is implied or would have been obvious to one of ordinary skilled in the art to modify Walker and allow the person to withdraw from the gaming environment subsequent to presenting the at least one rule to the person and prior to commencing the cooperative game. As discussed above, Walker discloses that each group member may establish the rules prior to commencement of the game (establish group's objective and format, paragraph 145). When users choose different aspects of a group format they desire, they may be placed by the casino server into different groups (paragraph 145). Therefore it is implied that an option is present for the user to withdraw from the current group and join a different group according to his/her preferred rules. Furthermore,

Walker discloses that the members may quit the group during linked play (paragraph 253). Walker also discloses that the steps of providing the group play (as illustrated in Fig. 12) may be practiced in any order, sequence, and/or timing that is practicable (paragraph 117). It would have been obvious and it is common sense to present an option to allow the person to withdraw or quit from the group in the order prior to commencement of the game and after the rules are presented if the person does not like the rules for the group play. Otherwise the person will be obligated to play in the group play without agreeing with the rules. Therefore it would have been obvious to one of ordinary skilled in the art the time the invention was made to modify Walker and present an option to withdraw from the cooperative gaming environment subsequent to presenting the at least one rule to the person and prior to commencing the cooperative game in order to allow the person quit the cooperative gaming environment if the person does not like the rules for the group play.

Claims 65, 75. Walker discloses at least a minimum number of persons joined in the cooperative gaming group (paragraph 229); and allowing the cooperative game to commence if it is determined that the minimum number of persons have joined the cooperative gaming group (paragraph 229, s3 in Fig. 12).

Claims 66, 76. Walker discloses prompting the person to provide rule information; and establishing the at least one rule based on the rule information (group



members choose the format and objectives using the gaming devices, paragraphs 144-145).

Claims 67, 77. Walker discloses allowing the person to specify how much the person wishes to wager during play of the cooperative game play (paragraph 67, discloses specifying the wager amount as a group format).

Claims 68, 79. Walker discloses establishing at least one rule occurring following the person to join (It is interpreted that to join refers to joining or registering to the cooperative gaming environment. See rejection for claim 64 since establishing the at least one rule occurs after receipt of the acceptance.).

Claims 69, 80. Walker discloses that the allowing of a person to withdraw from the cooperative gaming environment occurs following the presenting of the at least one rule (See rejection for claim 64 above since allowing the person to withdraw is subsequent to presenting the at least one rule to the person.).

Claims 71, 82. Walker discloses establishing of at least one rule includes changing the at least one rule (Rules can include changes of the rules, i.e. when a group member leaves; paragraph 57. Furthermore, the player established rule may change if the group members choose a different rule; paragraph 145.).

Claims 72, 83. Walker discloses the game controller is further configured to present another rule during the cooperative game (Walker discloses that multiple rules are available for the cooperative game, paragraphs 57-58, 253-254).

### ***Response to Arguments***

Applicant's arguments filed 8/19/09 have been fully considered but they are not persuasive. New grounds of rejection have been made using the same art to address the amended limitations.

Applicant's remarks indicate that claims 64-83 are pending. It is noted that claims 70, 73, 78, 81 are cancelled. Therefore claims 64-69, 71-72, 74-77, 79-80, 82-83 are pending.

Claims 64-69, 71-72, 74-77, 79-80, 82-83 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Applicant argues that that paragraph 65 and 96 provide support for the amended limitations. paragraph 65 discloses that, "players can be invited to join the cooperative gaming environment is to register their interest with a software implemented registration module of the central control unit 16 so that, when a cooperative gaming environment presents itself, the players are invited to participate." However, the descriptions of accepting to join the cooperative gaming environment or joining the cooperative gaming environment is directed to joining or accepting the cooperative game within the

cooperative gaming environment. The player does not initially join the cooperative game before the rules are established. Instead the player only registers to participate in the cooperative gaming environment. Paragraph 96 discloses that, "at each stage the system displays the choice and the players have the option to continue or to withdraw." This describes that the player can continue to join the cooperative gaming environment and play the cooperative game, or withdraw from the cooperative gaming environment for the cooperative game. Therefore the player does not join the cooperative gaming environment before establishing the rules because joining the cooperative gaming environment will involve the player to accept the rules and in the cooperative game. Instead, a player first registers to the cooperative gaming environment. After a player registers, at least one rule is established. After the at least one rule is established, the player can then accept to join the cooperative gaming environment when commencing the cooperative game. Therefore a registered player may not accept to participate in the cooperative gaming environment (as explicitly disclosed in paragraph 42 of Applicant's specification).

Claims 64-69, 71-72, 74-77, 79-80, 82-83 rejected under Walker.

Applicant has amended the claims to recite that a player can withdraw from the cooperative gaming environment subsequent to presenting the at least one rule to the person and prior to commencing the cooperative game. Applicant argues that Walker discloses that "arrangements or measure may be provided to accommodate a group with a member who wishes to quit the group during kinked play. For instance, a group

member may not wish to make any further wagers or the group member may be required to be somewhere else". That is, the player is only provided an exit option only after the linked play has started and after the group objective and format has been established. However, although this embodiment describes a player has an option to exit after the group objective and format has been established, Walker's invention is not limited to this embodiment. Walker does not disclose that the player is only provided an exit option only after the linked play has started and after the group objective and format has been established. As discussed above, Walker implicitly teaches that the player is provided an option to exit after establishing the rules and before the linked play starts. Walker discloses that each group member may establish the rules prior to commencement of the game (establish group's objective and format, paragraph 145). When users choose different aspects of a group format they desire, they may be placed by the casino server into different groups (paragraph 145). When a player is placed to a different group, they are withdrawn from the previous gaming environment and move to different gaming environment. Furthermore, as discussed in the claim rejection above, it would have been obvious to present for the user an option to withdraw from the cooperative gaming environment subsequent to presenting the at least one rule to the person and prior to commencing the cooperative game in the order to allow the person not participate in the group game if the person does not like the rules for the group play. Otherwise the person will be obligated to play in the group play without agreeing with the rules.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASSON H. YOO whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jasson H Yoo/  
Examiner, Art Unit 3714